

REMARKS

I. Status of Claims

Claims 1-77 are pending in this application. Claims 14-20, 22-38, 51, 56, 62, 64, 66, and 73-76 have been withdrawn as being directed to non-elected subject matter.

In the present Amendment, claim 61 has been amended to correct an obvious error. Applicants have not introduced any new matter by the amendment, nor are any estoppels intended thereby.

II. Rejection under § 103(a)

The Examiner rejects claims 1-4, 10-13, 21, 39-45, 48-50¹, 52-55, 57-61, 63, 65, 67-72, and 77 under 35 U.S.C. § 103(a) as being unpatentable over Arnaud et al. (U.S. Patent No. 5,961,998) (“Arnaud”) in view of Kantner et al. (U.S. Patent No. 6,433,073) (“Kantner”). Office Action, pages 1 and 2. Specifically, the Examiner alleges that *Arnaud* discloses a lipstick with pigments (col. 4, lines 63-64) and parleam (col. 5, line 45). *Id.* at page 2. The Examiner further alleges that *Kantner* “teaches a polyurethane dispersion useful in cosmetics such as lipsticks for forming hydrophobic films” (citing the title, col. 5, lines 29-36). *Id.* Therefore, the Examiner concludes that it would have been obvious for one of ordinary skill in the art to use the dispersion of *Kantner* in the lipstick

¹ The Examiner indicates on page 1 of the Office Action that claims 1-4, 10-13, 21, 39-45, 48-50, 52-55, 57-61, 63, 65, 67-72, and 77 are rejected. (Emphasis added). However, on page 2 of the Office Action, it states that “[c]laims 1-4, 10-13, 21, 39-50, 52-55, 57-61, 63, 65, 67-72, 77 are rejected under 35 U.S.C. 103(a).” (Emphasis added). Applicants reasonably believe that this statement on page 2 of the Office Action involves an error, because the section 103(a) rejection is the sole rejection in this Office Action and the Examiner further indicates on page 3 of the Office Action that claims 46 and 47 “are objected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form . . . ” Accordingly, Applicants respectfully request clarification of the records.

of *Arnaud* for the beneficial effect of forming a hydrophobic film. *Id.* at page 3.

Applicants respectfully disagree for at least the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met, including that (1) there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and (2) there must be a reasonable expectation of success for the modification or combination. M.P.E.P. § 2143. "Both the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

First, the Examiner has failed to point to any evidence of a suggestion or motivation to use the dispersion of *Kantner* in the lipstick of *Arnaud*. *Kantner* discloses "a stable polyurethane dispersion in alcohol-water system." Col. 1, lines 6-7 (emphasis added). *Kantner* further teaches that "[s]table polyurethane dispersions in hydro-alcohol (i.e., alcohol-water) systems are especially difficult [to form]." Col. 1, lines 39-65 (emphasis added). Therefore, in view of these teachings, one of ordinary skill in the art would not be motivated to combine the dispersion disclosed in *Kantner* with compounds that are not taught in *Kantner*, such as the at least one hydrocarbon-based oil as recited in, for example, Claim 1 of the present invention, because the addition of compounds that are not taught in *Kantner* into *Kantner*'s polyurethane dispersion in alcohol-water system is likely to destroy its stability, which is difficult to be formed.

The sole reason alleged by the Examiner in support of his obviousness assertion to use the dispersion of *Kantner* in the lipstick of *Arnaud* is "for the beneficial effect of

forming a hydrophobic film." Office Action, page 3. However, as clearly indicated in *Kantner*, and admitted by the Examiner, it is the stable polyurethane dispersion in alcohol-water system disclosed in *Kantner* that has the ability to form hydrophobic films. See col. 5, lines 29-30 and Office Action, page 3. If the stability of the polyurethane dispersion in alcohol-water system is destroyed by combining it with compounds that are not taught in *Kantner*, such a beneficial effect of forming hydrophobic films might not be achieved.

Second, the Examiner has failed to point to any evidence of a reasonable expectation of success in using the dispersion of *Kantner* in the lipstick of *Arnaud* to form "the at least one continuous liquid fatty phase containing at least one hydrocarbon-based oil and structured with at least one polymer . . . said at least one polymer being soluble or dispersible in said at least one hydrocarbon-based oil" as recited in, Claim 1, of the present invention. The Examiner relies on *Arnaud* for its teaching of parleam (an example of the at least one hydrocarbon-based oil) and on *Kantner* for its teaching of polyurethane (an example of the at least one polymer). However, as discussed above, the teaching of the polyurethane in *Kantner* is limited to the stable dispersion in alcohol-water system. Therefore, the Examiner has not met his burden of proving existence of a reasonable expectation of success to form "the at least one continuous liquid fatty phase" as recited in, for example, Claim 1 of the present invention by using the dispersion of *Kantner* in the lipstick of *Arnaud*.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

III. Objections

The Examiner objects to Claim 61 because of an informality in line 1, "comprisinga." Office Action, page 3. Claim 61 has been amended to correct this obvious error, rendering this objection moot. Accordingly, Applicants respectfully request this objection be withdrawn.

The Examiner further objects to claims 5-9, 46, and 47 "as being dependent upon a rejected base claim," but indicates that these claims "would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Office Action, page 3. Applicants respectfully submit that Claim 5 is an independent claim, and claims 6-9, 46, and 47 are dependent claims related to Claim 5. Therefore, claims 5-9, 46, and 47 are not dependent upon a rejected base claim as alleged by the Examiner. Accordingly, Applicants respectfully submit that claims 5-9, 46, and 47 should be allowable.

IV. Conclusion

In view of the foregoing amendment and remarks, Applicants respectfully request the reconsideration and reexamination of this application, and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned Applicants' representative at (202) 408-4218.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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